

**REMARKS**

Claims 1 -15 are currently pending in the application. Claims 1-13 and 15 are rejected under 35 U.S.C. §§ 102(b) and/or 103(a). Further, Examiner objected to the Specification. Applicants appreciate Examiners recognition of patentable subject matter in Claim 14.

**Amendments**

Applicants have amended the paragraph spanning pages 4 and 5 of the Specification to replace the term "resistance" with the term "durability" as suggested by the Examiner.

Applicants have amended claims 1, 9, 10 and 12 to replace the term "support material" with the term "separation gel." This amendment is supported *inter alia* at pages 5 and 7 of the specification. Thus, no new matter has been added.

Applicants have amended claim 14 to remove the redundant recitation of "separation gel" and to replace the term "substance" with the term "substrate", which corrects an obvious typographical error. This amendment is supported *inter alia* in the other claims. Thus, no new matter has been added.

**Objection to the Specification**

Examiner objected to the use of the term "resistance" in the Specification. It is Examiner's position that one skilled in the art would interpret the term to refer to electrical conductivity of the material of construction for the capillaries. Applicants respectfully disagree with the Examiner's position on this point. Nonetheless, merely to forward the prosecution of the application, Applicants have adopted Examiner's suggestion of the term "durability" as a more appropriate term. Applicants point out that the literal translation of the phrase "genügenden widerstandsfähigkeit" found in the original German language version of the application is "sufficient ruggedness."

Applicants further point out that this amendment is merely an adjustment to the translated phrase, and should not be construed as a disclaimer of any materials of construction based on electrical conductivity.

**Rejections Under 35 U.S.C. § 102(b)**

Claims 1, 2, 4-8, 10, 11, 13 and 15 were rejected under 35 U.S.C. § 102(b) as anticipated by various references.

M.P.E.P. § 2131 states that, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Since the references were applied separately, Applicants will deal with each rejection separately.

**i. Rejection over WO 90/11876 ("Carr et al")**

Examiner rejected Claims 1, 2, 4, 5 and 7 as anticipated by Carr et al. Claim 1 is the independent claim.

Carr et al discloses a punch assembly for punching holes in flexible photopolymer sheeting. The assembly disclosed by Carr et al includes multiple punches for producing regularly spaced holes in photopolymer films. The punch assembly disclosed by Carr et al is obviously directed towards the production of polymer sheeting where the spacing of holes at regular intervals along the edge of the film needs to be highly accurate for the purpose of rolling such films. (See Carr et al, pp. 1-2).

Amended claim 1 recites a sample taking apparatus arranged for receiving a plurality of samples from a separation gel. The apparatus comprises a plurality of separation tools for taking samples of the separation gel. The separation tools are arranged on a holding device

and are provided with separate actuating means by which the separation tools can be separately controlled and moved.

Based on Examiner's recognition of patentable subject matter in Claim 14, Applicants have included the feature of a "separation gel" into amended Claim 1. Applicants respectfully submit that Carr et al does not disclose a device suitable for sampling a separation gel. The device of Carr et al is configured for punching holes in a photopolymer film, where a hole is punched entirely through the thickness of the film.

Applicants therefore respectfully submit that because Carr et al does not disclose each and every feature of Claim 1, Claim 1 cannot be anticipated by Carr et al. Further, Applicants respectfully submit that because Claims 2, 4, 5 and 7 depend from Claim 1, they also cannot be anticipated by Carr et al. Reconsideration is respectfully requested.

**ii. Rejection over US 5144872 (Kakimoto)**

Examiner rejected Claims 1, 4, 5, 7, 10 and 13 as anticipated by Kakimoto. Claims 1 and 10 are the independent claims.

Kakimoto discloses multiple punch press for piercing a workpiece. (Kakimoto, col. 1, Ins. 67-68). The multiple punch press of Kakimoto also includes a punch pin, which prevents an individual punch in the press from piercing the work piece when the punch pin is actuated. (Kakimoto, col. 2, Ins. 26-37).

The subject matter of amended Claim 1 was described above. Amended Claim 10 recites a method for cutting samples from a separation gel and transferring said samples onto a target substrate. The method comprises cutting said samples from a separation gel successively in time using a sample taking apparatus having a plurality of separation tools, which are separately controlled and moved, and transferring said samples onto said target substrate simultaneously in parallel. Based on Examiner's recognition of patentable subject

matter in Claim 14, Applicants have included the feature of a "separation gel" into amended Claim 10.

Applicants respectfully submit that the device of Kakimoto is similar to the punch of Carr et al in that it is not suitable for sampling a separation gel. The device of Kakimoto is configured for punching holes entirely through (piercing) a workpiece. Therefore, Applicants respectfully submit that Kakimoto does not teach each and every element of either of independent Claims 1 or 10.

Applicants therefore respectfully submit that because Kakimoto does not disclose each and every feature of Claims 1 and 10, those claims cannot be anticipated by Kakimoto. Further, Applicants respectfully submit that because Claims 2, 4, 5 and 7 depend from Claim 1, and Claim 13 depends from Claim 10 they also cannot be anticipated by Kakimoto. Reconsideration is respectfully requested.

**iii. Rejection over US 5306510 (Meltzer)**

Examiner rejected Claims 1, 5-8, 10, 11 and 15 as anticipated by Meltzer. Claims 1 and 10 are the independent claims.

The subject matter of amended Claims 1 and 10 was described above. Meltzer discloses an automated pipetting system for programmably (sic) pipetting predetermined quantities of liquid between preselected groups of test tubes, vials or wells. (Meltzer, Abstract). Therefore, Meltzer discloses a liquid sampling device, which is not suitable for sampling a separation gel as recited in Claims 1 and 10. Therefore, Applicants respectfully submit that Meltzer does not disclose each and every element of independent Claims 1 and 10.

Applicants therefore respectfully submit that because Meltzer does not disclose each and every feature of Claims 1 and 10, those claims cannot be anticipated by Meltzer. Further, Applicants respectfully submit that because Claims 5-8 depend from Claim 1, and Claims 11

and 15 depend from Claim 10 they also cannot be anticipated by Meltzer. Reconsideration is respectfully requested.

**Rejections Under 35 U.S.C. § 103(a)**

Examiner has rejected Claims 3, 9, 10, 12 and 13 under 35 U.S.C. § 103(a) as obvious over various references.

M.P.E.P. § 2143 states that in order to establish a *prima facie* case of obviousness three basic criteria must be met. First there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach all of the claim limitations. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the in the prior art, not in the applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

Applicants respectfully submit that Examiner cannot establish any of the three requirements for a case of *prima facie* obviousness. The cited references do not teach each and every limitation of the claimed invention. Further, there is no motivation to combine or reasonable expectation of success for the suggested combination to be found in either the references themselves or the knowledge generally available in the art.

**i. Rejection of Claim 3**

The Examiner has rejected Claim 3 as obvious over Carr et al. Applicants respectfully submit that Claim 3 cannot be obvious over Carr et al either alone or in combination with the other references of record for the following reasons.

Claim 3 depends from Claim 1, which was discussed above. Carr et al was also discussed above. Applicants respectfully submit that for the same reasons stated above,

claim 3 cannot be obvious over Carr et al. As discussed above, Carr et al does not disclose a device suitable for taking samples from a separation gel.

Applicants therefore respectfully submit that Claim 3 cannot be obvious over Carr et al. Reconsideration is respectfully requested.

**ii. Rejection of Claims 10 and 13**

The Examiner has rejected Claims 10 and 13 as obvious over Carr et al in light of Kakimoto. Applicants respectfully submit that Claims 10 and 13 cannot be obvious over Carr et al either alone or in combination with Kakimoto for the following reasons.

Claim 10 is the independent claim and was discussed above. Both Carr et al and Kakimoto were also discussed above.

As discussed above, neither Carr et al nor Kakimoto discloses a device suitable for sampling a separation gel. The combination of Carr et al with Kakimoto does nothing to cure the fundamental deficiencies of these references individually.

Applicants therefore respectfully submit that Claim 10 cannot be obvious over the combination of Carr et al and Kakimoto. Further, because Claim 13 depends from Claim 10, Applicants respectfully submit that this claim also cannot be obvious over the combination of Carr et al with Kakimoto. Reconsideration is respectfully requested.

**iii. Rejection of Claims 9 and 12**

Examiner rejected Claims 9 and 12 as obvious over Meltzer in view of US 5587062 (Togawa). Applicants respectfully submit that Claims 9 and 12 cannot be obvious over Meltzer either alone or in combination with Togawa for the following reasons.

Claim 9 depends from Claim 1, which was discussed above. Claim 12 depends from Claim 10, which was discussed above. Meltzer was also discussed above.

Togawa discloses an apparatus for sampling a gel electrophoresis plate. The apparatus disclosed by Togawa has only a single cutting tool. As discussed above, Meltzer

discloses an apparatus for pipetting predetermined quantities of liquid between preselected groups of test tubes, vials or wells. (Meltzer, Abstract). Therefore, Togawa and Meltzer do not address the same problem, i.e. sampling a separation gel. Applicants respectfully submit that the combination of Togawa with Meltzer is not proper, since they are not analogous devices.

Applicants respectfully submit that because the combination of Meltzer and Togawa is not proper it cannot render either of Claims 1 or 10 obvious, and therefore cannot render either of Claims 9 or 12 obvious. Reconsideration is respectfully requested.

#### CONCLUSION

Applicants believe that the foregoing amendments and remarks have overcome or rendered moot all grounds for rejection or objection. There being no other rejections or objections, Applicants believe that the application is in a condition for allowance. Applicants therefore respectfully request prompt action on the claims and allowance of the application. If the Examiner believes that personal communication will expedite prosecution of the application, the Examiner is invited to telephone Applicants' undersigned agent directly.

**AUTHORIZATION**

Applicants believe that no extension of time is required to make submission of this response timely. However, in the event that an extension of time is required, Applicants hereby submit a petition for such extension of time as may be necessary to make this response timely. The Commissioner is hereby authorized to charge the necessary fees to deposit account No. 502194. A duplicate of this authorization is enclosed.

Respectfully Submitted,  
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Date: May 3, 2005

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